

JFW

Atty. Dkt. No. 034536-0920

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

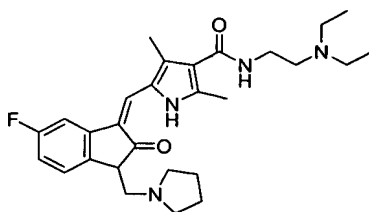
Applicant: Malcolm Wilson MOON et al.
Title: MANNICH BASE PRODRUGS OF 3-(PYRROL-2-YL-METHYLIDENE)-2-INDOLINONE DERIVATIVES
Appl. No.: 10/743,909
Filing Date: 12/24/2003
Examiner: R. Anderson
Art Unit: 1626

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed August 25, 2004, Applicants hereby provisionally elect Group I (claims 37-46) for examination on the merits. To comply with the PTO's additional requirement to "elect" a single compound, Applicants identify a compound of formula I wherein R¹, R³, R⁵, R⁶, and R⁷ are hydrogen; R⁴ is fluoro; R⁸ and R¹⁰ each are methyl; R⁹ is (2-diethylaminoethyl)-aminocarbonyl, and R^{3'} and R^{4'}, together with the nitrogen atom to which they are attached, form pyrrolidin-1-yl. This compound is disclosed, for example, in the specification at page 23, lines 4-10:




Applicants understand that a search and examination on the merits should not proceed on the basis of the PTO's "review [of] the claims and disclosure to determine the scope of the independent invention," Office Action at page 3, but rather in accordance with the strictures of MPEP § 803.02. Thus, Applicants respectfully decline the PTO's invitation for Applicants to "set forth a group of compounds which are so similar within the same inventive concept and reduction to practice." Office

Action at page 5. Applicants already have clearly defined their invention, not "inventive concept," by "set[ting] forth" the claims now pending before the PTO.

Having fully complied with the PTO's requirement to restrict, Applicants now await an early and favorable action on the merits. If the Examiner feels that a telephone interview would advance the prosecution of this application, she is invited to contact the undersigned.

Respectfully submitted,

Date 24 September 2004 By 

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5475
Facsimile: (202) 672-5399

Beth A. Burrous
Attorney for Applicant
Registration No. 35,087